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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,111	02/27/2004	Futoshi Koike	ASA-1163	5065

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EXAMINER

LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/787,111	Applicant(s) KOIKE ET AL.	
	Examiner Matthew J. Ludwig	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the application filed February 27, 2004.

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on May 21, 2003. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

2. Claims 1-19 are pending in the application. Claims 1, 18, and 19, are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 3, 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In reference to dependent claim 3, 5, the limitations state a reflecting unit for preparing a minute adapted to put together said comment and position information'. The vexatious nature of the claim language fails to particularly point out and distinctly claim the subject matter. The language is vague and indefinite. More specifically, the phrase fails to accurately describe what how or what is meant by the term 'put together' and the phrase 'minute'. Both terms fail to define information that would be required to utilize applicant's invention.

In reference to dependent claim 4, the limitation includes the phrase 'searches position information correlating to said retrieved comment and commands an editor for edition of

said review document', which fails to provide the examiner with a clear understanding of what is meant by the term commands and edition. Furthermore, it is unclear to the examiner as to how to emphatically display a position corresponding to said position information in said review document.

Specification

5. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: In reference to the specification, page 10, line 15, the term '*minute*' seems to define some type of function, but does not seem to be a concise translation. Furthermore, page 10, line 26, states that '*pictures on the screens are configured as shown therein in the first embodiment of the invention*'. It is unclear to the examiner what the applicant means by pictures on the screen. Finally, with reference to independent claim 1, the limitation recites a '*storage, which stores management information defining acquisition items*'. The term storage is not clear to the examiner and could be an actual filing cabinet for storing paper document. Appropriate correction required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In reference to independent claim 1-19, the claims read on a mental process or the manipulation of an abstract idea. The claim limitations are not explicitly directed toward steps being implemented on a computer, computer readable medium, or other statutory device. As such, they could be carried out mentally in conjunction with pen and paper. The claimed steps do not define a machine or computer implemented process (see MPEP 2106). Therefore, the claimed invention is directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. **Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Day et al., USPN 6,243,722 filed (11/24/1997).**

In reference to independent claim 1, 18 and 19, Day teaches:

The vexatious nature of the first limitation leaves the limitation open to different interpretations. The Day reference teaches a typical style-based implementation which might attach comment points for unsolicited comments to paragraphs, definition list parts, examples, ling quotes, list items, and so forth (compare to “*defining acquisition items of position information in a review document*”). See column 7, lines 45-55.

Each of these review buttons can be located anywhere within document and associated with a particular element (i.e., word, phrase, text, symbol, etc.) within document. The comment may be logged and recorded and retrieved subsequently by the author of the document for use in completing the document. See column 8, lines 5-67. The user provides a comment based upon a review button that signifies specific location information within the source document (compare to *“input unit which receives, from a user, an input including a designation of a position in said review document...”*).

The comment may be logged and recorded and retrieved subsequently by the author of the document for use in completing the document. The comments are not part of the reviewed document itself, but are instead associated with the document by appropriate identification links (compare to *“acquiring unit responsive to said input unit which acquires said position information from a position designated by said user in accordance with said management information...”*). See column 8, lines 30-67.

The comment may be logged and recorded and retrieved subsequently by the author of the document for use in completing the document (compare to *“searches, from said storage, said position information and comment associated with said review document”*). See column 8, lines 40-55.

Figure 8 illustrates a display unit which displays position information in the ‘see log’ file within the display and the comments section is below the position information and includes space provided for content (compare to *“a display unit which collectively displays said position information and comment associated with said review document”*). See figure 8.

In reference to dependent claim 2-5, Day teaches:

SGML elements altered subsequent to a previous edition might have been flagged with a revision attribute. In conversion to HTML, the scope of the altered portions are highlighted in color and an appropriate review button is added at the beginning or end of such portions. Each of these review buttons can be located anywhere within document and associated with a particular element within the document. See column 7, lines 60-67 and column 8, lines 1-16.

In reference to dependent claim 6, Day teaches:

Users who have controlled access may comment on writer-designated locations with the document, comment on other general features, and review comments made by other reviewers. See column 7, lines 23-39.

In reference to dependent claim 7, Day teaches:

Figure 8 illustrates a field which requires the user to identify them by placing their name in the reviewer field. See figure 8.

In reference to dependent claim 8, Day teaches:

Figure 8 illustrates a toolbar utilized by a user for searching through comments and posting comments within specified review documents. See figure 8.

In reference to dependent claim 9, Day teaches:

Figure 8 illustrates a comment space utilized by a user in making comments to a document in review. It would have been inherent in the teaching of May to include a priority order in the space provided so the author or next reviewer could make the necessary changes. See figure 8.

In reference to dependent claims 10-17, the claims recite similar limitations to those found in claims 2-9 for performing comments on a review document. Therefore, the claims are rejected under similar rationale.

Conclusion

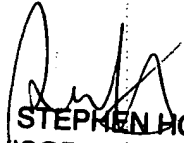
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ohashi USPN 6,796,486 filed (2/14/2001)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


STEPHEN HONG
SUPERVISORY PATENT EXAMINER

ML
May 9, 2006